

Application Serial No. 10/699,595

REMARKS/ARGUMENTS

Claims 1-8 are pending.

The claims stand rejected as follows:

Claims	Rejection
1, 2, 4, 6-7	35 U.S.C. 103(a) as unpatentable over Thomson (US 3,799,093) in view of Gonzalez (US 3,779,192) and Shorter, Jr. (3,967,569)
3,5, 8	35 U.S.C. 103(a) as unpatentable over Thomson (US 3,799,093) in view of Gonzalez (US 3,779,192), Shorter, Jr. (3,967,569) and Rytand et al. (US 6,450,737)

All rejections are thus respectfully traversed.

With regard to the foregoing rejections, it is noted that the Gonzalez and Shorter references relied upon by the Examiner fail to suggest any manner for modification of the structure of the Thomson reference.

Under 35 U.S.C. 103(a), the Examiner carries the initial burden of establishing a prima facie case of obviousness. In *re Pianski*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). As part of this, the Examiner must determine whether the differences between the subject matter of the claims and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art."

The rejection must rest on a factual basis with those facts being interpreted without hindsight reconstruction of the invention from the prior art. *See, In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The Federal Circuit has repeatedly cautioned against employing hindsight by using the applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated and disconnected teachings of the prior art. *See, Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

In overview, the Thomson reference is relied on by the Examiner for teaching the basic structure of a pretensioned concrete float unit featuring a foam core encased in concrete. The Gonzalez reference is relied on by the Examiner for teaching protecting foam from water damage. The Shorter reference is relied on by the Examiner as "motivation" for modification of the Thomson structure to include a "protected" core.

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The cited Gonzalez reference shows a floatation unit having a concrete channel slab that provides an upper portion of the unit, with a float unit foam float below the slab. The Gonzalez float unit is not of a construction having a foam float or other buoyant core encased in concrete. Rather, as noted at Col. 4, 49-53, the structure is designed to be open to ingress and egress of water.

The Examiner relies on the cited Shorter, Jr reference for teaching that it was known that "cracks may occur in concrete below the waterline." Based on this, the Examiner asserts that it would have been obvious to modify the device of Thomson to add the polyethylene coating of Gonzalez around the foam core of the Thomson device. However, as will be noted, Shorter does not attribute any negative to the development of cracks. Rather, Shorter describes that "use of the foam block permits the unit to float even though cracks develop in the concrete below the water line."

Accordingly, the Examiner's reliance on the Shorter, Jr. reference does not establish that one of ordinary skill in the art would view the concrete encased foam structure of Thomson or Shorter, Jr. as requiring any correction or modification. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification obvious unless the desirability of such modification is suggested by the prior art. See, In re Fitch, 23 USPQ2d 1780 (Fed. Cir. 1992).

Reconsideration and issuance of a notice of allowance is requested. In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355**.

Respectfully submitted,

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*** * * CERTIFICATE OF FACSIMILE TRANSMISSION * * ***

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office
at 703-872-9306, Attn: Examiner Andrew D. Wright, Art Unit. 3617

on AUGUST 23, 2004



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